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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/636,100	08/07/2003	Christopher Schwarz	L3440/277452	9133

23370 7590 10/21/2005

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EXAMINER

PAYER, HWEI SIU CHOU

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/636,100

Applicant(s)

SCHWARZ ET AL.

Examiner

Hwei-Siu C. Payer

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11 and 13-15 is/are rejected.
- 7) ☒ Claim(s) 6 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

The response filed on 8-16-2005 has been entered. The copy of UK Patent No. GB 2391828 has not been received. No amendment to the pending claims has been made in this response.

Status of Claims:

(1) Claims 1-5, 7-11 and 13-15 are rejected for the same reasons set as forth in the previous Office action (mailed on May 23, 2005).

(2) Claims 6 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Remarks

Applicant argues, at page 4 of the amendment, there is no suggestion or motivation available to one of ordinary skill in the art to modify Bodmer by shortening the blade or lengthening the body. Examiner disagrees. Fletcher suggests providing a blade contact surface (12a) with an extending portion (extending beyond one end of a blade, see Figs.1-2) and a recessed portion (12c) to protect a user from injury on one of the cutting edges of the blade (10) and to protect the cutting edge from damage by the blade contact surface (12a), respectively. Therefore, it would have been obvious to one

skilled in the art to modify Bodmer by providing the blade contact surface (2) with an extending portion and a recessed portion for the advantages set forth.

Applicant also argues the age of references is persuasive evidence of unobviousness of the combination of the teachings when there is evidence that notwithstanding the knowledge of the references, the art tried and failed to solve the problem. In response to Applicant's argument based upon the age of the reference, contentions that the reference patents are old is not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. In re Neal, 179 USPQ (CCPA 1973). The length of time between the issuance of prior art patents relied upon is not persuasive of unobviousness. Ex parte Meyer, 6 USPQ2d 1966. Also, see M.P.E.P. 2145 VIII.

The fact that no one has gotten a patent on this specific combination does not necessarily mean that it is not obvious. It merely means that no one has gotten a patent on this combination. The reason why might be, simply, because the combination is obvious.

The declaration of Iain M. Campbell filed on 8-16-2005 has been given very little probative value for the following reasons:

(1) Mr. Campbell has not established there was a commercial success because he did not give competitive figures for sales for the entire market. Mr. Campbell has only compared sales of this instant cabinet scraper (the Lee Valley Cabinet Scraper) with a prior Stanley version cabinet scraper. Further, it is not clear what the difference

between “the Lee Valley cabinet scraper line” and “the Lee Valley Cabinet Scraper”. What does it mean by “a prior version of a cabinet scraper, the Stanley version, was dropped from the Lee Valley cabinet scraper line when the Lee Valley Cabinet Scraper was introduced”? Is the Lee Valley cabinet scraper line advertising both the Stanley version cabinet scraper and the Lee Valley Cabinet Scraper? How can a fair comparison between the Stanley cabinet scraper and the Lee Valley Cabinet Scraper be made if the Stanley cabinet scraper was dropped (no longer available) when the Lee Valley Cabinet Scraper was introduced?

(2) Mr. Campbell has also failed to establish the nexus between the commercial success and the inventive features. The commercial success may be due to features found in the prior art (i.e. the body having two integrally formed handle and a planar sole for contact with a workpiece to facilitate easier manipulation of the scraper).

(3) Mr. Campbell’s statement “the company has maintained generally the same level of promotion and advertising of its products, including the cabinet scraper line” cannot provide the evidence that the commercial success is not due to other factors such as sale promotions, advertising, etc. There are no comparisons with similar competitive cabinet scrapers with respect to their commercial success and factors or lack thereof influencing their sales such as sale promotions, advertising, etc. Further, the sale of the Lee Valley Cabinet Scraper of total 5,714 units in the past three to four years might be, as well, due to the increasing of home sales and the need of cabinet scrapers for home improvement and not due to “commercial success”.

Action Made Final

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 571-272-4511. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for official communications and 571-273-4511 for proposed amendments.

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Art Unit: 3724

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H Payer

H Payer
October 18, 2005

~~Primary Examiner~~
~~H Payer~~